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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/321,839	05/28/99	PENSAK	D 11953.0002

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LMC1/0802

EXAMINER

SULPIZIO JR, R

ART UNIT	PAPER NUMBER
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2767

*4*

DATE MAILED: 08/02/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

**Application No.**

09/321,839

**Applicant(s)**

PENSAK ET AL.

**Examiner**

Ronald F. Sulpizio

**Art Unit**

2767

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 3 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erickson (US Patent 5,765,152) and Saito (US Patent 6,002,772).

#### Claims 1 and 3

Erickson teaches a method of controlling distribution of electronic information comprising the steps of:

- retrieving, at a user location, a segment of encrypted electronic information (Erickson Col. 19, Lines 1-5, Col. 26, Lines 5-10);
- receiving, from a key server, (a) a copy of a decryption key for the segment (Erickson Col. 16, Lines 55-64), and (b) at least one user limitation assigned to the segment and associated with the decryption key (Erickson Col. 16, Lines 60-64);
- accessing the segment using the copy of the decryption key at the user location for the segment and a control process the control process responsive to a user

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limitation to control distribution of the electronic information (Erickson Col. 16, Lines 55-64; Col. 20, Lines 17-21; Col. 22, Lines 48-65);

Erickson, however, fails to teach destroying the copy of the decryption key at the user location after accessing the segment. Saito, on the other hand, teaches this (See Saito Col. 16, Lines 1-10). In light of Saito, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify Erickson's system to include the destruction of the decryption key, than not modify it, in order to prevent subsequent unauthorized use of the decryption key and access to the electronic information.

The precondition to receiving a decryption key for accessing a second segment of the electronic document of Claim 3 is not positively recited to differentiate over the prior art of Saito, which teaches the destruction of the decryption key.

#### Claim 2

Erickson teaches the method of controlling distribution of electronic information as in claim 1 above, wherein access to the decryption key is controlled by the key server subject to unique segment identification associated with the segment and the user limitation associated with the segment (Erickson Col. 18, Lines 3-10).

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**Conclusion**

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Schneck and Sachs patents are cited because they are inventions very similar to the Applicant's.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald F. Sulpizio whose telephone number is (703) 308-2391.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod R. Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-0040 for regular communications and (703) 308-5065 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

  
Ron Sulpizio  
Examiner  
Art Unit 2767

rfs  
28 July, 2000

GILBERTO BARRÓN, JR.  
PRIMARY EXAMINER  
... UNIT 222 762